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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,911

12/08/2003

Toshiki Naito

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03/22/2007

SUGHRUE-265550

2100 PENNSYLVANIA AVE. NW

WASHINGTON, DC 20037-3213

EXAMINER

DINH, TUAN T

ART UNIT

PAPER NUMBER

2841

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/728,911

Applicant(s)

TOSHIKI NAITO ET AL.

Examiner

Tuan T. Dinh

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2,4,7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) \*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) \*  
Paper No(s)/Mail Date 10/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/22/07 has been entered.

#### **Note of the claimed language:**

The term “**capable of**”, which is equivalent as “adapted to or configured to”, performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison* USPQ 138.

#### ***Claim Objections***

2. Claim 10 is objected to because of the following informalities:

Claim 10, line 4, change “said electrically insulating cover layer” to - - said electrically insulating base layer - - for proper antecedence basis.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4, 7-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (U.S. Patent 6,313,526).

As to claims 1, 12, Nakamura discloses a tape carrier for TAB (1), comprising: a carrying support film (3) having a plurality of opening portions (32, see figures 3a-3b, column 8, line 18), and individual pieces of flexible wiring boards (2), each of which includes an electrically insulating base layer made of a resin film (column 6, lines 65-67) and an electric conductor layer made of a metal foil or copper foil (5, column 7, line 8, or element foil 35) having a predetermined wiring circuit pattern, wherein said flexible wiring boards (2) are mounted at regular intervals on said plurality of opening portions (32), respectively, on said carrying support film (3) and wherein said flexible wiring boards are capable of being inspected prior to being, mounted on said carrier support film (the flexible board 2 being capable of test or inspect prior/before to form on the TAB 1).

As to claim 2, Nakamura discloses each of said flexible wiring boards (2) mounted on said carrying support film (3) through an adhesive agent (column 7, lines 34-35).

As to claim 4, Nakamura discloses said carrying support film (3) is a polyimide film (column 7, lines 33-43).

As to claim 7, Nakamura discloses each of said opening portions (32, figure 3) having a rectangular shape that is similar in shape but slightly smaller in size than said individual pieces of said flexible wiring boards (2).

As to claim 8, Nakamura discloses said flexible wiring boards (2) are arranged on said opening portions (32) through adhesive layers.

As to claims 9-11, Nakamura discloses a thickness of said electrically insulating base layer (2) is in a range from 3  $\mu\text{m}$  to 100  $\mu\text{m}$  (column 6, lines 64-65) and a thickness of said conductor layer (foil 35) is in a range from 3  $\mu\text{m}$  to 50  $\mu\text{m}$  (column 8, line 30).

As to claims 13-14, Nakamura discloses the support film (3) formed at a range (35, 48, and 70 mm) so that said opening portions having a longitudinal width in a range from 9 mm to 99 mm and a lateral width in a range from 9 mm to 64 mm.

As to claims 15-16, Nakamura discloses the support film (3) formed at a range (35, 48, and 70 mm) so that a pitch of arrangement of said opening portions is in a range from 1 mm to 10 mm.

As to claim 17, Nakamura discloses a circuit sheet (3), comprising: an electrically insulating base layer (2); a conductor layer (5, 35) formed of metal foil disposed on said base layer; an electrically insulating cover layer (12) covering said conductor layer; and terminal portions for performing connection of said conductor layer to electronic parts (IC chip), wherein portions of said circuit sheet are cut out to form individual flexible wiring boards (2) that are **capable of being** inspected for defects before being mounted to a tape carrier (1).

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-2, 4, and 7-17 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chia et al. and Kitano et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T. Dinh whose telephone number is 571-272-1929. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reichard Dean can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Tuan Dinh', with a stylized, cursive script.

Tuan Dinh  
March 16, 2007.